

## **REMARKS**

### **I. Introduction**

Claims 10-14 and 16 are now pending in the present application after cancellation of claims 15, 17 and 18. Claims 10, 11 and 14 have been amended. Applicant hereby respectfully requests further examination and reconsideration of the application.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority, and the indication that all certified copies of the priority documents have been received.

### **II. Objection to the Drawings**

In response to the Examiner's objection to the drawings as failing to comply with 37 CFR 1.84(p)(5) because they include reference characters not mentioned in the description (element numbers 2 and 3 of Fig. 1), Applicant has amended the specification to clearly describe each reference character, thereby obviating the basis for the Examiner's objection.

### **III. Rejection of Claims 10-18 under 35 U.S.C. § 101**

Claims 10-18 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Claims 15, 17 and 18 have been canceled. Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

Initially, Applicant notes that the Examiner's rejection of claims 10-14 is clearly flawed: claim 10 recites "a . . . plug-in memory unit for storing software," which is clearly a statutory machine or manufacture, and there is no logical basis for the Examiner to contend that the claimed "memory unit" is "abstract in nature." In any case, independent claim 10 has been amended to recite, in relevant parts, "**wherein the copy-protected plug-in memory unit is configured to transport software in an encrypted form from a hardware device to the controller.**" Independent method claim 14 has been amended to recite substantially similar features as the above-recited features of claim 10, i.e., amended claim 14 recites "transferring software from a hardware device to a copy-protected plug-in memory unit; storing the software in an encrypted form in the copy-protected plug-in memory unit; and transferring the software stored in the copy-protected plug-in memory unit to the controller."

As amended, claims 10 and 14 clearly recite tangible, useful subject matter.

For at least the foregoing reasons, claims 10 and 14, as well as dependent claims 11-13 and 16, clearly recite statutory subject matter.

**IV. Rejection of Claims 10 and 14 under 35 U.S.C. § 102(b)**

Claims 10 and 14 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,453,417 (“Milios”). Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

In order to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result or characteristic.

Amended claim 10 recites, in relevant parts, “a portable, copy-protected plug-in memory unit for storing software, **wherein the copy-protected plug-in memory unit is configured to transport software in an encrypted form from a hardware device to the controller.**” Amended claim 14 recites “transferring software from a hardware device to a copy-protected plug-in memory unit; storing the software in an encrypted form in the copy-protected plug-in memory unit; and transferring the software stored in the copy-protected plug-in memory unit to the controller.”

Milios refers to determining a signature for the contents of a copy-protected memory of a controller. Milios, at column 2, lines 51-55, summarizes the objective of the system recited therein: "It is thus desirable to have a way to make a system including a controller, in which the stored program of the controller is safe from prying eyes, and yet in which a party wishing to confirm the contents of the stored program, as for regulatory purposes." The copy-protection disclosed in Milios is in reference to the **memory of a controller, and not in reference to any sort of portable, plug-in memory unit.** Milios clearly does not disclose or suggest a **portable, copy-protected plug-in memory unit,** let alone teach or suggest a memory unit configured to **transport software in an encrypted form from a hardware device to the controller.** In fact, Milios merely refers to verifying firmware programming, but Milios never refers to transporting software.

For at least the foregoing reasons, claims 10 and 14 are allowable over Milios.

V. **Rejection of Claims 11-13 and 15-18 under 35 U.S.C. § 103(a)**

Claims 11-13 and 15-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Milios in view of U.S. Patent No. 6,505,105 ("Allen"). Claims 15, 17 and 18 have been canceled. Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijekaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements" in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning

with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Applicant notes that claims 11-13 ultimately depend on claim 10, and claim 16 depends on claims 14. As discussed above, Milios fails to anticipate claims 10 and 14. Furthermore, as discussed below in detail, Allen fails to remedy the deficiencies of Milios as applied against parent claims 10 and 14.

Allen refers to calibrating an electronic control unit (ECU) that includes a microcontroller, a first non-volatile memory bank, a second non-volatile memory bank and a volatile memory. “During calibration, the microcontroller is coupled to an external tool that allows a user to modify calibration constants that the microcontroller uses to control a subsystem coupled to the ECU.” (Allen, col. 2, lines 45-49). When referring to the external tool, Allen uses as an example a personal computer controlled by a user. (Allen, col. 3, line 39). A personal computer controlled by a user is in stark contrast to the presently-claimed **portable, copy-protected plug-in memory unit**. More specifically, Allen makes no disclosure or suggestion relating to a **portable, copy-protected plug-in memory unit configured to transport software in an encrypted form from a hardware device to a controller**. Indeed, the Examiner does not suggest that Allen makes such a disclosure, but instead relies on Allen for its supposed teaching of an interface, as presently recited in claim 11, for example.

As regards the rejection of claim 11, the Examiner points to figure 1, element 112, of Allen as disclosing an interface. While element 112 of Allen links a microcontroller to an external tool, element 112 does not disclose or suggest **an interface for a portable, copy-protected plug-in memory unit**. Even in combination with Milios, the serial link portrayed by element 112 does not disclose nor suggest **an interface for a portable, copy-protected**

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**plug-in memory unit.** As discussed above, neither Milios nor Allen discloses or suggests a **portable, copy-protected plug-in memory unit.** Therefore, even if it were accurate to describe element 112 as an interface, there is no disclosure or suggestion of **an interface for a portable, copy-protected plug-in memory unit.**

For at least the foregoing reasons, dependent claims 11-13 and 16 are not rendered obvious by the combination of Milios and Allen. Withdrawal of the obviousness rejection is respectfully requested.

### **Conclusion**

In view of the foregoing, it is respectfully submitted that pending claims 10-14 and 16 are in condition for allowance. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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